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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/570,834

01/12/2007

Joseph Finan

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8769

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7590

06/26/2007

DUANE MORRIS, LLP

IP DEPARTMENT

30 SOUTH 17TH STREET

PHILADELPHIA, PA 19103-4196

EXAMINER

YAN, REN LUO

ART UNIT

PAPER NUMBER

2854

MAIL DATE

DELIVERY MODE

06/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/570,834

Applicant(s)

FINAN, JOSEPH

Examiner

Ren L. Yan

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/3/06, 5/30/07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-15 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15 of prior U.S. Patent No. 6,920,822. This is a double patenting rejection. The only difference between claims 1-15 of the present application and claims 1-15 of the patent is that the word "object" is used in the claims of the present application while the word "can" is used in the claims of the patent. Since a can is an object and thus claims 1-15 of the present application are claiming identical subject matter as that of claims 1-15 in the patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-9 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al(5,799,574) in view of Granzow(5,677,719). The patent to Williams et al teaches

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the structure and method of a can printing apparatus as claimed including a rotatable blanket carrier 21 having a plurality of blanket sections mounted on its exterior, a plurality of color ink decorating sections 22 for providing each of the blanket sections with a color pattern, a can transport device 18 having mandrels 20 mounted thereon for supporting cans to be printed and rotatable to contact each can with a corresponding blanket section to enable transfer of an ink image from the blanket section to the respective can, and the can transport device 18 further rotates to transport each can printed by a respective blanket section away from the blanket carrier 21 for further process such as varnishing. See Fig. 1 and column 3, line 26 through column 4, line 3 in Williams et al for details. However, Williams et al do not teach to provide ink pattern on the blanket sections of the printing apparatus with a digitally controlled print head. The patent to Granzow teaches in a transfer printing apparatus using a blanket cylinder 58 for transferring color ink images to a substrate the conventionality of using digitally controlled inkjet print heads 18, 20, 22 to selectively or simultaneously provide colored ink image patterns on the blanket sections 11, 13 and 15 of the blanket cylinder 58 so as to enable the image transfer when the blanket cylinder contacts the substrate 30. See Figs. 1-9 in Granzow for example. It would have been obvious to those having ordinary skill in the art at the time of invention to provide the blanket sections of Williams et al with corresponding digitally controlled inkjet print heads as the ink image pattern generating means in order to greatly improve the efficiency and reliability of the can printing operation. With respect to claims 5, 6, 13-15 and 20, Williams et al teach to varnish the printed cans with an over-varnish unit 24 and use a transfer wheel 27 to transfer the printed cans 16 off the transport device 18 after varnishing as recited. With respect to claims 8

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and 12, an ink reservoir is an inherent part of an inkjet print head in order for the inkjet print head to carry out the ink jetting operation during printing.

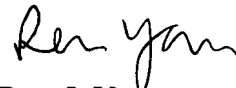
Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al in view of Granzow as applied to claims 1-3 and 9 above, and further in view of applicant's admitted prior art. Williams et al, as modified by Granzow, teaches all that is claimed except for the computer control for sensing the position of the blanket carrier and the blanket sections. As is admitted in paragraph [0020] of the present specification, the computer control 54 used in the present invention to sense the locations of the blanket sections with respect to the print heads 50 and to activate the print heads at the appropriate times for printing the selected color and pattern on the blanket section is conventionally known. It would have been obvious to those having ordinary skill in the art at the time of invention to provide the printing apparatus of Williams et al, as modified by Granzow with the known computer control so as to ensure that the print heads will be activated at the correct timing and to improve print quality. The mere application of a well known computer control based upon its well known properties and intended use in order to achieve an expected outcome would have been obvious to one of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L. Yan whose telephone number is 571-272-2173. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ren L Yan
Primary Examiner
Art Unit 2854

Ren Yan
June 15, 2007